



UNITED STATES PATENT AND TRADEMARK OFFICE

A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/066,243 | 02/01/2002 | Bernel Goldberg | 3715P2308CIP2 | 3596 |

23504 7590 12/15/2005

WEISS & MOY PC
4204 NORTH BROWN AVENUE
SCOTTSDALE, AZ 85251

| |
|----------|
| EXAMINER |
|----------|

DUONG, OANH L

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2155

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,243

Applicant(s)

GOLDBERG, BERNEL

Examiner

Oanh Duong

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-14, 17-23, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 15, 16, 24 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-27 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 8, 10, 11, 17, 19-20 and 26 are rejected under 35 U.S.C.

103(a) as being unpatentable over Walsh (US 2002/0107924 A1) in view of Tsai (US 6,839,741 B1).

Regarding claim 1, Walsh teaches the invention substantially as claimed including a method for completing an e-mail transmission (Fig. 3 abstract), comprising:

receiving a user input indicating that an e-mail message is complete (i.e., indicating an e-mail message is complete by sending the email message, page 2 paragraphs 22 and 27);

checking customization settings to determine whether or not to offer modification of the email message (i.e., detecting/checking indicators/customization setting whether to prompt/offer modification/attaching to email message, page 2 paragraph 25); and

in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the email message (i.e., detecting and automatically prompt the user to modify/attach to the email, page 1 paragraphs 8 and 33).

Walsh does not explicitly teach modify the text of the email message to notify a recipient of a detected customization setting.

Tsai teaches a facility wherein electronic mail message attachments are accessed (see abstract). Tsai teaches detect the presence of a customization (i.e., a detector that detects the presence of the attachment/customization, col. 6 lines 29-30) and insert/modify text indicating that the customization is present in the e-mail (i.e., inserts a notification/text into the email that notifies the recipients of the presence of the attachment/customization, col. 6 lines 64-66).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walsh to insert text to notify a recipient of a detected customization setting/attachment as in Tsai. One would be motivated to do so to allow recipient to easily recognize the existence of the attachment file/customization setting by only reading the text of the email message (Walsh, page 2 paragraph 23 lines 1-3).

Regarding 10, a system of claims 10 performs a corresponding method of claim 1; therefore, claim 10 is rejected under the same rationale as applied to claim 1.

Regarding claim 19, a computer program product comprising program instructions for performing corresponding steps of claim 1; therefore, claim 20 is rejected under the same rationale as applied to claim 1.

Regarding claims 2, 11 and 20, Walsh teaches parsing said message to determine whether or not said user has already entered text that will notifying a recipient of a particular customization setting (page 2 paragraph 23); and in response to said parsing detecting said entered text, skipping said generating of said user prompt for said particular customization setting (i.e., if the result of the determination is negative, then only primary document is processed, page 2 paragraph 21).

Regarding claims 8, 17 and 26, Walsh teaches particular customization setting is a copy recipient list, and wherein said modification modifies said text to include a "cc:" list (page 4 paragraphs 36-38).

3. Claims 3-5, 12-14 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh in view of Tsai, and further in view of Chrabaszcz (US 6,073,133).

Regarding claims 3, 12 and 21, Walsh-Tsai does not explicitly teach user input as claimed.

Chrabaszcz teaches the user input instructing an e-mail program to send the e-mail message (col. 2 lines 1-3 and coll. 5 lines 29-34).

Art Unit: 2155

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Walsh-Tsai to include the user input instructing an email program to send the e-mail message as taught by Chrabaszczyk because such user input would initiate a sequence of computer-readable instructions to be executed in order to ensure an electronic mail message is complete before the message is transmitted to recipients (Chrabaszczyk, col. 1 lines 57-60).

Regarding claims 4, 13 and 22, Walsh-Tsai-Chrabaszczyk teaches said user input indicating that said e-mail message is complete is a user input instructing an e-mail program to save said e-mail message (Chrabaszczyk, col. 5 lines 29-34).

Regarding claims 5, 14 and 23, Walsh-Tsai-Chrabaszczyk teaches said user input indicating that said e-mail message is complete is a user input instructing an e-mail program to check said e-mail message (Chrabaszczyk, col. 5 lines 29-34).

4. Claims 9, 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh in view of Tsai, and further in view of Okumura et al. (Okumura) (US 2002/0049793 A1).

Regarding claims 9, 18 and 27, Walsh-Tsai does not explicitly teach said modifying modifies a subject line of said message to include an indication of said level of urgency.

Art Unit: 2155

Okumura, in the same field of endeavor, teaches modifying a subject line of the email message (pages 4 paragraphs 75-85).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Walsh-Tsai to include modifying a subject line of the email message because it would enable an improper subject to be eliminated (Okumura, page 4 paragraph 88).

Allowable Subject Matter

5. Claims 6-7, 15-16 and 24-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of prior art teaches said automatically modifying modifies said text of the email message to include the string "Attachment (s)" when a file attached to the email message has been detected, in responsive to an input indicating that an e-mail message is complete.

Response to Arguments

6. Applicant's arguments filed 09/23/2005 have been fully considered but they are not persuasive.

In the remarks, applicants argued in substance that

(A) Prior art does not teach or suggest detect the presence of a customization and insert text indicating that the customization is present in the e-mail.

Art Unit: 2155

As to point (A), Tsai does teach detect the presence of a customization (i.e., a detector that detects the presence of the attachment/customization, col. 6 lines 29-30) and insert text indicating that the customization is present in the e-mail (i.e., inserts a notification/text into the email that notifies the recipients of the presence of the attachment/customization, col. 6 lines 64-66).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh Duong whose telephone number is (571) 272-3983. The examiner can normally be reached on Monday- Friday, 2:00PM - 10:30PM.

Art Unit: 2155

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

O.D



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER